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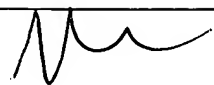
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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/725,837  | 12/01/2003  | Tony Reid            | 017622-000130US     | 3216             |
| 20350   | 7590        | 06/29/2004           | EXAMINER            |                  |
| TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                      | THANH, QUANG D      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3764                |                  |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



|                              |                 |   |  |
|------------------------------|-----------------|---|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 10/725,837      | REID, TONY  |  |
|                              | Examiner        | Art Unit  |  |
|                              | Quang D. Thanh  | 3764  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/16/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

*A.M*



## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1- 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-6, 15, of U.S. Patent No. 6,656,141. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the patented claims and the proposed application claims are minor and obvious from each other. The claims of the present application are broader and are met by the narrower patented claims. In the instant case, claims 1, 5-6, 15, of U.S. Patent No. 6,656,141 disclose all the structures of the present application: a first sleeve having ridges (protrusions), a second sleeve, a third sleeve, made of thin fabric having low friction that can exert pressure in the range of 5mmHg to 60 mmHg.



***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Myers (814,795).

5. Re claims 1 and 5, Myers discloses a system for applying pressure (“compressive covering” disclosed on line 9) to a body limb, said system comprising: a first innermost therapeutic pressure sleeve 1 (TPS) having ridges 3 formed over an inner surface, configured to be slid over the limb (figs. 1 and 3) and to apply an inward pressure onto the limb; a second sleeve 4 configured to be slid over the first sleeve and to apply additional inward pressure onto the limb; and a third sleeve 4 (“4 represents a series of outer encircling bands” as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto said limb (fig.1 shows an inner sleeve 1 and two outer sleeves 4).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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7. Claims 2-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers.

8. Re claims 2 and 6, Myers discloses that the sleeve may be made of rubber or other flexible material (lines 33-38) , and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a flexible material that also has a low friction characteristic to assist in removing the sleeve, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Re claim 7, Myers discloses a third sleeve 4 ("4 represents a series of outer encircling bands" as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto the limb (fig.1 shows an inner sleeve 1 and two outer sleeves 4).

10. Re claims 3 and 8, the second and third sleeves 4 appear to be thin bands (fig. 1) and it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a flexible fabric material to make these outer sleeves, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

11. Re claims 4 and 9, Myers discloses that "elastic bandages are usually made in such manner as to afford a uniform and constant pressure on the part to which they may be applied" (lines 47-50) , and therefore depending on the size of the user and the



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limb the device is placed on, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to configure the Myers' sleeve such that it would be capable of providing a wide range of radially inward pressure , including slight pressure or greater pressure in the range of 5 mmHg to 30mmHg.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (703) 605-4354. The examiner can normally be reached on Monday-Thursday & alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (703) 308-2698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quang D. Thanh  
Patent Examiner  
Art Unit 3764  
June 24, 2004



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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700